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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/903,556	07/13/2001	Lausan Chung-Hsin Liu	LIUL3022/EM/6990	2127

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EXAMINER

LECHERT JR, STEPHEN J

ART UNIT	PAPER NUMBER
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1732

DATE MAILED: 01/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/903,556

Applicant(s)

LIU, LAUSAN CHUNG-HSIN

Examiner

Stephen J. Lechert Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

- 1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:**

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

- 2. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Sugiyama.**

Sugiyama teaches a method of making a substrate of non-stone materials comprising the steps of molding non-stone substrate which is a fence post or a gate and covering the substrate with a blend of adhesive stone and additive to form a coating on the substrate, drying the and curing the coating to solidify the coating to provide a composite artificial stone surface on a substrate. With respect to applicant proviso in the preamble that the method fabricates furniture is given no patentable weight because this a mere intended use. The method as claimed by Sugiyama fully anticipates applicant's method steps by providing a substrate which is coated with a blend of

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adhesive and artificial stone which is cured and bonded to form the composite. It is immaterial to the method whether a fence post or furniture or a gate is made by the method.[Note the abstract]

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

- 1. Determining the scope and contents of the prior art.**
- 2. Ascertaining the differences between the prior art and the claims at issue.**
- 3. Resolving the level of ordinary skill in the pertinent art.**
- 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.**

5. Claims 2-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sugiyama in combination with Baskin.

Sugiyama teaches the invention substantially as claimed.

Sugiyama teaches a method of making a substrate of non-stone materials comprising the steps of molding non-stone substrate which is a fence post or a gate and covering the substrate with a blend of adhesive stone and additive to form a coating on the substrate, drying the and curing the coating to solidify the coating to provide a composite artificial stone surface on a substrate. With respect to applicant proviso in the preamble that the method fabricates furniture is given no patentable weight because this a mere intended use.

However, Sugiyama does not teach applicant's particular substrates, the bonding and curing steps using a catalyst or the addition of pigment to the artificial stone.

Baskin teaches an artificial stone coating which is applied to a pre-made substrate. Baskin teaches that the artificial stone coating which is applied to a substrate can be furniture.[Note Column 6, line 15] Baskin further teaches in Column 4, lines 2-4 , wood products which can be used as the substrate which are similar to the substrates claimed in claim 2. Baskin teaches that pigments can be

used as an additive in the artificial stone coating composition.[Note Column 2, line 4] Baskin also teaches that the artificial stone coating on the substrate is made using a polymerization catalyst for curing the artificial coating onto the substrate.[Note Column 3, line 58]

It would have been obvious from the teachings of both Sugiyama and Baskin to provide applicant's methods as claimed because as stated above Sugiyama has taught applicant steps of using an artificial stone composition which is coated and cured onto a substrate. Baskin teaches the deficiencies of Sugiyama with respect the using a catalyst, the type of substrate, time of curing and that the method can be used for making furniture thus applicant's invention is rendered wholly obvious from the combined teachings of these references.

With respect to applicant's recitation regarding injection molding, the method taught by Sugiyama broadly suggest molding which would encompass injection as well as compression molding and thus and obvious molding technique. With respect to the specific artificial stone composition as claimed, this would have been an

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obvious optimization of the composition from reading either Sugiyama or Baskin as both teach providing an artificial stone composition which is bonded and cured onto a substrate. The normal desire of the artisan to improve upon what is already generally known provides the motivation to determine percent ranges for optimization. It is maintained that applicant's method has been fairly taught and suggested by the prior art and rendered as a whole obvious to one of ordinary skill in the art.


6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Z. Liu CN 1323679A [English Abstract Only] teaches a method of making imitation stone furniture where a mixture of adhesive, stone material, and an additive form a paint which is then uniformly coated on the surface of the furniture.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen J. Lechert Jr. whose telephone number is 571-272-1203. The examiner can normally be reached on 9:30-6:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael P. Colaianni can be reached on 571-272-1196. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-0987.


Stephen J. Lechert Jr.
Primary Examiner
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